

IN THE DRAWINGS

The attached sheet of drawings includes changes to Figure 1. This sheet, which includes Figure 1, replaces the original sheet including Figure 1.

Attachment: One Replacement Sheet

REMARKS/ARGUMENTS

Favorable consideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-4, 6-14, and 16-21 are pending in the application.

In the outstanding Office Action, the drawings were objected to; Claims 1-4, 6-8, and 21 were rejected under 35 U.S.C. §103(a) as unpatentable over Clark et al. (U.S. Patent No. 6,784,869, hereinafter "Clark") in view of Ebert et al. (U.S. Patent No. 5,931,874, hereinafter "Ebert"); Claim 9 was rejected under 35 U.S.C. §103(a) as unpatentable over Clark in view of Ebert and further in view of Oder et al. (U.S. Patent No. 5,475,594, hereinafter "Oder"); Claims 10, 15-18, and 20 were rejected under 35 U.S.C. §103(a) as unpatentable over Clark in view of Bier et al. (U.S. Patent No. 5,561,811); Claims 11-14 were rejected under 35 U.S.C. §103(a) as unpatentable over Clark in view of Bier and further in view of Ebert; and Claim 19 was rejected under 35 U.S.C. §103(a) as unpatentable over Clark in view of Bier and further in view of Oder.

With regard to the objection to the drawings, an amended Figure 1 is provided herewith including labels for the elements noted in the outstanding Office Action. Accordingly, the objection to the drawings is believed to be overcome.

With regard to the rejection of Claim 1 as unpatentable over Clark in view of Ebert, that rejection is respectfully traversed.

Claim 1 recites in part:

discretely displacing an auxiliary object marker on the display, *responsive object by responsive object*, so as to designate a responsive object without affecting control of the main object marker.

Clark describes a display management system including cursor control device (CCD) 212 that includes a *touch screen* 212d to *continuously* move a single cursor on a display screen. The switches 212a<sub>1</sub>, 212a<sub>2</sub>, and 212a<sub>3</sub> move the *same* cursor from one *screen* to

another *screen*.<sup>1</sup> Thus controls 212a<sub>1</sub>, 212a<sub>2</sub>, and 212a<sub>3</sub> do *not* move an auxiliary cursor discretely in the display *from one responsive object to another responsive object*. It is respectfully submitted that there is no teaching or suggestion in Clark that the movement of the same cursor from screen to screen by the use of switches 212a<sub>1</sub>, 212a<sub>2</sub>, and 212a<sub>3</sub> is from one responsive object to another.

The outstanding Office Action cited switches 212a<sub>1</sub>, 212a<sub>2</sub>, and 212a<sub>3</sub> of Clark as “displacing an auxiliary object marker on the display, responsive object by responsive object.” In fact, the outstanding Office Action asserted that “the feature ‘jump the cursor’ corresponds to ‘moving the cursor discretely’ as claimed.”<sup>2</sup> However, Claim 1 recites “discretely displacing an auxiliary object marker on the display, *responsive object by responsive object*.” This omission of any part of a claim element is contrary to well settled case law which holds that *all* words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). (Emphasis added.) See also MPEP §2143.03. Thus, the description of jumping the cursor from *screen to screen* in Clark cannot teach or suggest this feature of Claim 1. Thus, Clark does not teach or suggest “discretely displacing an auxiliary object marker on the display, responsive object by responsive object” as recited in Claim 1.

Ebert describes a display 38 that displays cursors 44 and 50. The outstanding Office Action cited the movement of cursor 44 of Ebert as “displacing an auxiliary object marker [44] on the display object [12] without affecting control of the main object marker [50].” However, auxiliary object marker 44 does not designate any responsive objects. Cursor 44 of Ebert is only used to designate a single target for a missile,<sup>3</sup> and thus is *not* used to designate *any responsive objects*. Thus, cursor 44 of Ebert is not used in “*discretely* displacing an

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<sup>1</sup>See Clark, column 5, lines 57-60 and column 6, lines 26-28.

<sup>2</sup>The outstanding Office Action, page 13, lines 3 and 4.

<sup>3</sup>See Ebert, column 8, lines 27-30.

auxiliary object marker on the display, *responsive object by responsive object*, so as to designate a responsive object without affecting control of the main object marker.”

Therefore, Ebert does not teach or suggest “discretely displacing an auxiliary object marker on the display, responsive object by responsive object, so as to designate a responsive object without affecting control of the main object marker” as recited in Claim 1 either.

Further, there is no suggestion or motivation to modify the device of Clark to create the claimed invention. If controls 212a<sub>1</sub>, 212a<sub>2</sub>, and 212a<sub>3</sub> did move a *second* cursor discretely, responsive object by responsive object, there would be no way to move the *first* cursor from screen to screen. Accordingly, the first cursor would be unsuitable for its intended purpose, which is to be available for use on all the screens of the display management system.<sup>4</sup> Well settled case law holds that if proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). See also MPEP §2143.01. Thus, there is no suggestion or motivation to make the proposed modification to Clark.

The outstanding Office Action asserted that the above-quoted case law is limited to chemical inventions, and is not relevant to the present application.<sup>5</sup> In fact, the citation of this case law in MPEP §2143.01 does not state such a limitation, nor does the opinion appear to be limited as asserted in the outstanding Office Action. If this assertion is to be maintained, Applicant requests that an Advisory Action cite authority for this assertion so that the Applicant can address this issue fully in an Appeal Brief. With regard to the further statements in the outstanding Office Action regarding a reasonable expectation of success,<sup>6</sup> this issue was not raised by the Applicant and does not appear to be relevant. It is

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<sup>4</sup>See Clark, column 6, lines 40-42.

<sup>5</sup>See the outstanding Office Action at page 14, lines 19-21.

<sup>6</sup>See the outstanding Office Action at page 14, line 21 to page 15, line 7.

respectfully noted that *In re Gordon* is only cited in MPEP §2143.01, which discusses the requirements regarding a suggestion or motivation to combine references.

Accordingly, as neither Clark nor Ebert teach or suggest “discretely displacing an auxiliary object marker” as recited in Claim 1, and there is no suggestion or motivation to modify Clark as proposed, Claim 1 (and Claims 2-4, 6-9, and 21 dependent therefrom) is patentable over Clark in view of Ebert.

With regard to the rejection of Claim 9 as unpatentable over Clark and Ebert in view of Oder, it is noted that Claim 9 is dependent from Claim 1, and thus is believed to be patentable for at least the reasons discussed above. Further, it is respectfully submitted that Oder does not cure any of the above-noted deficiencies of Clark and Ebert. Accordingly, it is respectfully submitted that Claim 9 is patentable over Clark and Ebert in view of Oder.

With regard to the rejection of Claim 10 as unpatentable over Clark in view of Bier, that rejection is respectfully traversed.

Claim 10 recites in part:

providing a priority of movement on the display screen  
to the main object marker over the auxiliary object marker  
when the main object marker and the auxiliary object marker  
are located on a same window.

The outstanding Office Action conceded that Clark does not teach or suggest this feature, and cited Bier as describing this element.<sup>7</sup> Bier describes a system where multiple users *simultaneously* work on a same display. The assertion in the outstanding Office Action that Bier teaches that the red cursor has priority over the blue cursor is not supported by the cited portion of Bier, column 8, lines 23-36.<sup>8</sup> In fact, it is respectfully submitted that no portion of Bier teaches or suggests that any of the described cursors has a priority of movement over any other (i.e. all cursors can move independently). Thus, Bier does not

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<sup>7</sup>See the outstanding Office Action at page 8, lines 8-17.

<sup>8</sup>See the outstanding Office Action at page 8, lines 13-15.

teach or suggest "providing a priority of movement" as defined in Claim 10. Consequently, Claim 10 (and Claims 11-14 and 16-20 dependent therefrom) is patentable over Clark in view of Bier.

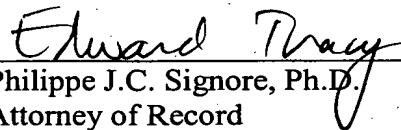
With regard to the rejection of Claims 11-14 as unpatentable over Clark and Bier in view of Ebert, it is noted that Claims 11-14 are dependent from Claim 10, and thus are believed to be patentable for at least the reasons discussed above. Further, it is respectfully submitted that Ebert does not cure any of the above-noted deficiencies of Clark and Bier. Accordingly, it is respectfully submitted that Claims 11-14 are patentable over Clark and Bier in view of Ebert.

With regard to the rejection of Claim 19 as unpatentable over Clark and Bier in view of Oder, it is noted that Claim 19 is dependent from Claim 10, and thus is believed to be patentable for at least the reasons discussed above. Further, it is respectfully submitted that Oder does not cure any of the above-noted deficiencies of Clark and Bier. Accordingly, it is respectfully submitted that Claim 19 is patentable over Clark and Bier in view of Oder.

Accordingly, in view of the present amendment and in light of the previous discussion, Applicants respectfully submit that the present application is in condition for allowance and respectfully request an early and favorable action to that effect.

Respectfully submitted,

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